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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,133	01/14/2004	Donn M. Delson	10008/00004	3829
23380	7590	09/22/2005	EXAMINER	
TUCKER, ELLIS & WEST LLP 1150 HUNTINGTON BUILDING 925 EUCLID AVENUE CLEVELAND, OH 44115-1475			NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	
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Please find below and/or attached an Office communication concerning this application or proceeding.

AK

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/757,133	DELSON, DONN M.
	Examiner	Art Unit
	Ismael Negron	2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 14 January 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) 10 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 01 June 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Title*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: **Marking Kit having UV Light Source and Implement for Invisible Marking**

### *Abstract*

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because uses phrases which can be implied. Correction is required. See MPEP § 608.01(b).

The Examiner respectfully suggests amending the abstract to read:

~~The present invention disclosed and claimed herein, in one aspect thereof, comprises a marking kit including a housing, a A marking implement to dispose an invisible mark onto a substrate and an ultraviolet light source disposed in communication with the housing to illuminate the invisible mark on the substrate.~~

### ***Claim Objections***

3. Claim 10 is objected to because of the following informalities: it recites an AC/DC converter to convert an AC input power to DC, however, it depends from Claim 9 which claims a DC power source. It is apparent that Claim 10 should be dependent on Claim 8, not 9. Appropriate correction is required.

The applicant is advised that in comparing the claims with the Prior Art the Examiner assumed Claim 10 to be depending from Claim 8.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  
5. Claim 6 uses the trademark VELCRO (registration number 661,700, to Velcro S.A. Corporation, of Switzerland) to identify or describe a particular element. The claim is indefinite since the trademark or trade name cannot be used properly to identify any particular element, material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in the claim to identify or describe an element, material or product would not only renders the claim indefinite, but would also constitutes an improper use of the trademark or trade name. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).
  
6. The applicant is advised that in comparing the claim to the Prior Art the Examiner assumed the applicant's usage of the trademark VELCRO to refer to hook-and-loop type fasteners.
  
7. Claim 15 is indefinite as it recites the limitation "*the paper medium*" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-5, 7, 9, 11, 12, 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by YU et al. (U.S. Pat. 6,860,616).
9. YU et al. discloses a device having:
  - **a housing (as recited in Claim 1)**, Figure 1, reference number 12;
  - **a marking implement (as recited in Claim 1)**, Figure 1, reference number 28;
  - **the marking implement being for disposing an invisible mark onto a substrate (as recited in Claim 1)**, column 2, lines 62-65;
  - **an ultraviolet light source (as recited in Claim 1)**, Figure 1, reference number 24;
  - **the light source being disposed in communication with the housing (as recited in Claim 1)**, as evidenced by Figure 1;
  - **the light source being to illuminate the invisible mark on the substrate (as recited in Claim 1)**, column 2, lines 62-65;

- **the invisible mark is an ultraviolet-sensitive ink mark (as recited in Claim 2), column 2, lines 52-55;**
- **the marking implement including a barrel (as recited in Claim 3), Figure 1, reference number 38;**
- **the marking implement including a well (as recited in Claim 3), Figure 1, reference number 36;**
- **the well being for holding a quantity of an ultraviolet light-sensitive composite (as recited in Claim 3), column 2, line 51;**
- **the well being disposed within the barrel (as recited in Claim 3), column 2, lines 51 and 52;**
- **the marking implement having an opening (as recited in Claim 3), Figure 1, reference number 37;**
- **the opening being disposed on one end of the barrel (as recited in Claim 3), as seen in Figure 1;**
- **the opening being for discharging the ultraviolet light-sensitive composite onto the substrate (as recited in Claim 3), inherent;**
- **the housing including a cavity (as recited in Claim 4), Figure 1, reference number 32;**
- **the cavity being for storing the marking implement (as recited in Claim 4), column 2, lines 35-38;**

- **the housing including fastening means (as recited in Claim 5), as seen in Figure 1;**
- **the fastening means being for securing the marking implement to the housing (as recited in Claim 5), column 2, lines 43-48;**
- **a power source (as recited in Claim 7), Figure 1, reference number 14;**
- **the power source being for providing power to illuminate the ultraviolet light source (as recited in Claim 7), column 2, lines 24 and 25;**
- **the power source being a direct current (DC) power source (as recited in Claim 9), column 2, line 16;**
- **a handle to carry the housing (as recited in Claim 11), as seen in Figure 1;**
- **the substrate being a paper medium (as recited in Claim 14), column 4, line 11; and**
- **the housing including a cavity to secure the paper medium (as recited in Claim 15), as seen in Figure 2.**

10. Claims 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by YU et al. (U.S. Pat. 6,860,616).

11. YU et al. discloses a device having:

- **a shaft (as recited in Claim 16), Figure 1, reference number 10;**
- **the shaft having a first end (as recited in Claim 16), as seen in Figure 1;**
- **the shaft having a second end (as recited in Claim 16), as seen in Figure 1;**
- **the shaft having a cavity located between the first and second end (as recited in Claim 16), , Figure 1, reference number 38;**
- **a well (as recited in Claim 16), Figure 1, reference number 36;**
- **the well being for holding a quantity of an ultraviolet light-sensitive composite (as recited in Claim 16), column 2, lines 51;**
- **the well being disposed within the cavity (as recited in Claim 16), column 2, lines 51-52;**
- **an opening (as recited in Claim 16), Figure 1, reference number 37;**
- **the opening being disposed on the first end of the shaft (as recited in Claim 16), as seen in Figure 1;**
- **the opening being for discharging the ultraviolet light-sensitive composite onto the substrate (as recited in Claim 16), inherent;**
- **an ultraviolet light source (as recited in Claim 16), Figure 1, reference number 24;**

- **the light source being disposed in communication with the second end of the shaft (as recited in Claim 16), column 2, lines 62-65;**
- **the light source being to illuminate the invisible mark on the substrate (as recited in Claim 16), column 2, lines 62-65;**
- **a power source (as recited in Claim 17), Figure 1, reference number 14; and**
- **the power source being for providing power to illuminate the ultraviolet light source (as recited in Claim 17), column 2, lines 24 and 25; and**
- **the power source being a direct current (DC) power source (as recited in Claim 18), column 2, line 16.**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6, 8, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over YU et al. (U.S. Pat. 6,860,616).

13. YU et al. discloses a device having:

- **a housing (as recited in Claim 1)**, Figure 1, reference number 12;
- **a marking implement (as recited in Claim 1)**, Figure 1, reference number 28;
- **the marking implement being for disposing an invisible mark onto a substrate (as recited in Claim 1)**, column 2, lines 62-65;
- **an ultraviolet light source (as recited in Claim 1)**, Figure 1, reference number 24;
- **the light source being disposed in communication with the housing (as recited in Claim 1)**, as evidenced by Figure 1;
- **the light source being to illuminate the invisible mark on the substrate (as recited in Claim 1)**, column 2, lines 62-65;
- **the housing including fastening means (as recited in Claim 5)**, as seen in Figure 1;
- **the fastening means being for securing the marking implement to the housing (as recited in Claim 5)**, column 2, lines 43-48;
- **a power source (as recited in Claim 7)**, Figure 1, reference number 14;
- **the power source being for providing power to illuminate the ultraviolet light source (as recited in Claim 7)**, column 2, lines 24 and 25; and

- **a handle to carry the housing (as recited in Claim 11), as seen in Figure 1.**

14. YU et al. discloses all the limitations of the claims, except:

- the fastening means being hook and loop means (as assumed from Claim 6);
- the power source being an alternating current (AC) power source (as recited in Claim 8);
- an AC/DC power converter for converting an AC power source to DC power (as recited in Claim 10);
- the handle being a strap (as recited in Claim 12); and
- a case to protect the housing (as recited in Claim 13).

15. It would have been an obvious to one having ordinary skill in the art at the time the invention was made to use hook-and-loop type fasteners as the fastening means of YU et al., since the examiner takes Official Notice of such hook-and-loop type fasteners being old and well known in the art. Selection of the claimed fastener, or any known equivalent, for securing the marking implement to the housing would have been an obvious matter of selecting a desire fastener to meet the specifics of a given application, as admitted by the applicant (see paragraph 0015, lines 3-10).

16. Regarding an AC power source and an AC/DC converter, it would have been an obvious to one having ordinary skill in the art at the time the invention was made to provide the patented invention of YU et al. with an AC/DC converter for converting an

AC power source to DC power (as recited in Claim 10), to be able to power the light source from an alternate power source other than the batteries of YU et al. (e.g. a conventional household wall outlet).

17. It would have been an obvious matter of design choice to use a strap as the handle of YU et al., since the applicant has not disclosed that using specifically a strap solves any problem or is for a particular reason. It appears that the claimed invention would perform equally well with the handle as shown by YU et al.. In addition, the Examiner takes Official Notice of applicants statements regarding the claimed strap as being merely an optional feature. See paragraph 0015, lines 1-3.

18. Regarding a case (as recited in Claim 13), it would have been an obvious to one having ordinary skill in the art at the time the invention was made to provide the patented invention of YU et al. with a case for storing such invention when not in use.

19. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over YU et al. (U.S. Pat. 6,860,616).

20. YU et al. discloses all the limitations of the claims (as detailed in Section 11, above), except the power source being an alternating current (AC) power source (as recited in Claim 19), and an AC/DC power converter for converting an AC power source to DC power (as recited in Claim 20).

21. Regarding an AC power source and an AC/DC converter, it would have been an obvious to one having ordinary skill in the art at the time the invention was made to provide the patented invention of YU et al. with an AC/DC converter for converting an AC power source to DC power (as recited in Claim 10), to be able to power the light source from an alternate power source other than the batteries of YU et al. (e.g. a conventional household wall outlet).

***Relevant Prior Art***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Hettrick** (U.S. Pat. 2,663,791), **Bartlett** (U.S. Pat. 2,811,632), **Huang et al.** (U.S. Pat. 6,099,185) and **Lo** (U.S. Pat. 6,164,856) disclose marking implements including a light source and a DC power source for power such light source.

**Cooper et al.** (U.S. Pat. 5,788,364), **Albert** (U.S. Pat. 6,476,385) and **Cooper et al.** (U.S. Pat. 6,491,408) disclose illumination devices having UV light sources for illuminating ultra-violet sensitive compositions.

***Conclusion***

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



THOMAS M. SEMBER  
PRIMARY EXAMINER



September 17, 2005